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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,699	04/19/1999	YASUSHI TANAKA	450108-4542	2687

20999 7590 03/26/2003

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EXAMINER

SALCE, JASON P

ART UNIT PAPER NUMBER

2611

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/284,699

Applicant(s)

TANAKA, YASUSHI

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 1/10/03 have been fully considered but they are not persuasive.

Applicant argues that the newly added limitation of "sequentially" displaying commercial information on a program guide screen is not disclosed by Schein. The Merriam-Webster's Collegiate Dictionary defines sequential as "arranged in sequence". With reference to Schein, the examiner points Figure 19B for one specific example of commercial advertisements being "sequentially" displayed. As clearly shown, email messages, in the form of advertisements are sequentially displayed one after another in a vertical manner. Schein also further discusses this menu at Column 23, Lines 19-36. Therefore, information is displayed sequentially in Schein's example, which covers this newly added limitation as claimed by the applicant.

Applicant continues to argue that "automatic display of a sequence of advertisements in a single window when the cursor is placed over commercial information, therefore requiring no further action by a user". The claim limitations do not address that advertisements are automatically displayed in sequence when a cursor is placed over one of the advertisements. Therefore, referring back to Figure 19B and Column 23, Lines 19-36, Schein discloses that a user can select an email (address information) advertisement ("when a cursor is moved onto a program column of said program guide screen") in Figure 19B, which will display the advertisement (commercial information). Therefore, since the limitation "automatic" is not disclosed in the

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applicant's limitations, Schein's disclosure as stated above continues to read on the applicant's claim limitations. The examiner also further notes that the "Messages" embodiment disclosed in Figure 19B contains emails, and that when a user selects one of the emails in Figure 19B that an advertisement for "Starsight Subscribers" is displayed. The examiner reads "transmitted" as implied by the specification, which is simply accessing the "CM" data from a data structure in memory, and "transmitting" that data to the display screen (see Page 28 of Applicant's specification). A further embodiment can be shown by window 528 in Figure 16A. As discussed at Column 22, Lines 3-8, Schein discloses that when a show is highlighted in matrix 506, all types of promotional information relating to the show being highlighted is displayed in window 528.

The examiner notes that the NFL cap embodiment of the Schein reference can also be applied to the arguments above. The examiner's rejection in the previous Office Action is repeated with further citation to clarify how Schein applies to the applicant's newly amended claim limitations.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schein et al. (U.S. Patent No. 6,002,394).

Referring to claim 1, Schein discloses transmitting program guide information together with a broadcasting program (Column 12, Lines 20-24). Schein also discloses commercial information that corresponds to program guide information (Column 20, Lines 51-54), which is sequentially displayed on a program guide screen in a receiver (Column 23, Lines 19-36 and Figures 19B and 19C) is transmitted with program guide information (see transmitting a advertisement database in Column 12, Lines 28-29 and Column 7, Lines 65-67). Schein also discloses transmitting additional commercial information when a cursor is moved onto a program column of said program guide screen (Column 19, Lines 19-36 and 19C for displaying a "Starsight Subscribers" advertisement after selecting a program column in Figure 19B). The examiner refers applicant to the arguments above to again stress that no distinction is made whether the cursor is being actuated or not actuated (automatically displayed) on the program guide in order to transmit the data when the cursor lies on the program column.

Referring to claim 2, Schein discloses that the commercial information contains image data (Column 11, Lines 56-57).

Referring to claim 3, Schein discloses that a digital signal can have separate bitstreams that contain video, audio, and program guide information (Column 6, Lines 51-60), and that data related to a television program guide title is related to an advertisement (Column 26, see Claim 14).

Referring to claim 4, Schein discloses that commercial information can be accessed on a remote computer via the Internet (Column 20, Lines 4-9), and that a computer on a computer network (Internet) can be given an IP address (Column 18, Lines 20-43).

Referring to claim 5, Schein discloses hierarchical levels for program schedule data (Column 9, Lines 20-67 and Column 10, Lines 1-28) for a program guide, which contains advertisements (Column 22, 10-18). Schein shows that a first hierarchical level (Channel Data Table) is smaller by holding only the channel required for viewing at a specific subscriber's receiver, while the second hierarchical level (show list) contains start times and additional scheduling data for 24 hours worth of program for every channel listed in the Channel Data Table (Column 9, Lines 20-62 and Figures 5 and 6). It is inherent that the Channel Data Table is smaller than the Show List Table because of the large amount of data storage that would be required to hold 24 hours or weeks worth of show times for each program contained in the Channel Data Table.

Referring to claim 6, Schein discloses a receiver for separating program guide information from a received broadcasting signal (Column 12, Lines 41-44). Schein also discloses displaying commercial information in a part of a display area (see Figure 21A and Column 24, Lines 1-20), and an electronic program guide screen including program columns corresponding to a plurality of programs based on the separated program guide information (see Figure 21A). Schein also discloses when a cursor is moved onto one program column that plural items of commercial information are sequentially displayed on a program guide (Figure 21C and Column 24, Lines 1-20).

Referring to claim 7, Schein discloses communicating with an external computer through a computer network (Column 20, Lines 4-9). Schein also discloses displaying further detailed information from an external computer based on address information to display the information when a cursor is moved onto one of the program columns (Figures 21B and 21C and Column 18, Lines 20-43 and Column 19, Lines 51-63).

Referring to claim 8, Schein discloses selecting a program column on a program guide, and displaying program details corresponding to the program column selected and to sequentially display plural items of commercial information included in the program in a part of the display area (see Figures 21A, 21B, and 21C and Column 24, Lines 1-19).

Referring to claim 9, Schein discloses displaying a commercial details screen (see top left window explaining NFL cap in Figure 21C).

Referring to claim 10, see rejection of claim 9.

Referring to claim 11, Schein discloses sponsors for presenting commercial information (Column 22, Lines 10-18).

Referring to claim 12, Schein discloses an address of a computer on a computer network, which provides detailed information of a commercial (Column 20, Lines 1-17 and Column 18, Lines 20-43).

Referring to claim 13, Schein discloses communicating with an external computer on a computer network (Column 20, Lines 4-9). Schein also discloses extracting the detailed information of the sponsor's commercial from the external computer by using

the address information of the computer (Column 18, Lines 20-43 and Column 20, Lines 51-54).

Referring to claim 14, see rejection of claim 2.

Referring to claim 15, see rejection of claim 3.

Referring to claim 16, see rejection of claim 6, with the added limitation of a plurality of advertisements being sequentially displayed when a cursor is moved onto a display area of the EPG. Further review of the "Messages" embodiment show that in Figure 19A, the user can move the cursor onto the "Messages" option, and when a user selects that option, more commercial information are sequentially displayed in Figure 19B. Again, there is no support for automatically displaying commercial information when a cursor is moved onto a program column, therefore, the claim language is broad enough to support if a user selected the program column. Further, the specification does not support automatically displaying commercial information when a user moves a cursor onto a program column.

Referring to claims 17-21, see rejections of claims 8-12, respectively.

Referring to claim 22, see rejection of claim 16.

Referring to claims 23-24, see rejection of claims 20-21, respectively.

Referring to claims 25-26, see rejection of claims 25-26, respectively.

Referring to claim 27, see rejection of claim 1 and note that in Figures 21A-21F, Schein disclose that the process of ordering an NFL cap is initiated while watching a related program (a football game). Also refer to Column 23, Lines 66-67 and Column 24, Lines 1-3.



Referring to claims 28-30, see rejection of claim 27.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



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March 24, 2003